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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/741,797	12/19/2003	Thomas E. Creamer	BOC9-2003-0111US1 (1082-1)	5601
7590	07/08/2005		EXAMINER BARNIE, REXFORD N	
Steven M. Greenberg, Esquire Christopher & Weisberg, P.A. Suite 2040 200 East Las Olas Boulevard Fort Lauderdale, FL 33301			ART UNIT 2643	PAPER NUMBER

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/741,797

Applicant(s)

CREAMER ET AL.

Examiner

REXFORD N. BARNIE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Rexford Barnie
REXFORD BARNIE
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/741,733. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same subject matter with minor wording variations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable Scherer (US pat# 6,411,692) in view of Florida Citizens or Wisconsin or Digital launches industry

Regarding claim 1, Scherer teaches a system for providing caller information to called party via standard data field comprising the steps of:

receiving a telephone call from a service subscriber over a PSTN in (see figs.);
identifying the service subscriber through identifying information received externally to the telephone call in (see col. 8, col. 10 lines 62-65, col. 12, col. 14 lines 28-36, col. 23 "Example 1" and so forth); and

storing on a database through which external information can be retrieved, information including name, SSN, address and so forth.

retrieving service information for a service subscribed to by the subscriber based upon the identifying information

Scherer fails to teach modifying a term of a subscription or renewing a subscription if payment can be provided, even though note payment information can be stored for car rentals and so forth.

Florida citizens are now able to renew vehicle registration via telephone wherein users can renew a service including vehicle registration or driving licenses if payment can be provided in the form of a check.

Wisconsin is set to jump on the credit card bandwagon teaches a communication system wherein motorist would be able to renew a service by dialing a toll-free number and providing payment through MasterCard or Visa or a debit card in (see disclosure).

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Digital teaches a communication service wherein a debit card service can be purchased and renewed as long as payment can be provided, which in this case would be a credit card.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either primary reference into that of Scherer thus making it possible to extend or renew services without having to go the service provider in person, saving transportation cost, providing convenience and to able to use desired service before/after expiration.

Regarding claims 2-4, the combination including Scherer renders obvious the ability to retrieve name and address information from any database in any network environment in (see figs., cols. 7-12)

Regarding claims 5-6, the combination renders obvious the ability to renew or extend a service term.

Regarding claim 8, Scherer teaches a system for providing caller information to called party via standard data field comprising the steps of:

receiving a telephone call from a service subscriber over a PSTN in (see figs.);

Identifying the service subscriber through identifying information received externally to the telephone call in (see col. 8, col. 10 lines 62-65, col. 12, col. 14 lines 28-36, col. 23 "Example 1" and so forth); and

Storing on the dataset through which external information can be retrieved, information including credit card information.

retrieving service information for a service subscribed by the service subscriber is taught by Scherer.

Scherer fails to teach modifying a term of a subscription or renewing a subscription if payment can be provided, even though note payment information can be stored for car rentals and so forth.

13/3, k/3 teaches a Florida citizens now able to renew vehicle registration via telephone wherein users can renew a service including vehicle registration or driving licenses if payment can be provided in the form of a check.

24/3, k/9 teaches a communication system wherein motorist would be able to renew a service by dialing a toll-free number and providing payment through MasterCard or Visa or a debit card in (see disclosure).

29/3 teaches a communication service wherein a debit card service can be purchased and renewed as long as payment can be provided, which in this case would be a credit card.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either secondary reference into that of Scherer thus making it possible to extend or renew services without having to go the service provider in person, saving transportation cost, providing convenience and to able to use desired service before/after expiration.

Regarding claims 9-11,, the combination including Scherer renders obvious the ability to retrieve name and address information from any database in any network environment in (see figs., cols. 7-12)

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Regarding claims 12-13, the combination renders obvious the ability to renew or extend a service term based on cited secondary references.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al. (US Pat# 6,744,877) in view of 13/3, k/3 or 24/3, K/9 or 29/3, k/4.

Regarding claim 1, Edwards teaches an enterprise application system or service management system in (see fig. 4, fig. 6, fig. 11, col. 10 lines 25-30, col. 11 lines 30-45, col. 12 lines 27-40, col. 17 line 57-col. 18 line 8, col. 20 lines 33-53, col. 25 lines 30-50) comprising:

- establishing a telephone call with a service subscriber over a PSTN
- receiving identifying information with the telephone call to identify the subscriber
- correlating the identifying information with the telephone call to identify the subscriber;
- retrieving service information for a service subscribed by the subscriber and managing or providing services accordingly.

Edwards fails to teach being able to extend services or renew services using a telephone network.

13/3, k/3 teaches a Florida citizens now able to renew vehicle registration via telephone wherein users can renew a service including vehicle registration or driving licenses if payment can be provided in the form of a check.

24/3, k/9 teaches a communication system wherein motorist would be able to renew a service by dialing a toll-free number and providing payment through MasterCard or Visa or a debit card in (see disclosure).

29/3 teaches a communication service wherein a debit card service can be purchased and renewed as long as payment can be provided, which in this case would be a credit card.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either secondary reference into that of Edwards thus making it possible to extend or renew services without having to go the service provider in person, saving transportation cost, providing convenience without having to invest in expensive equipment such as a computer and to able to use desired service before/after expiration.

Regarding claims 2-4, The combination teaches being able to query a database for pertinent and would be obvious to use any conventionally known database system.

Regarding claims 5-6, The combination renders obvious the ability to extend or renew services.

Regarding claim 7, Edwards teaches a service management system in (see fig. 6, fig. 14) comprising of a name resolution unit communicatively linked to a database (see col. 17 lines 58-col. 18 line 8, col. 20), an enterprise application and a service logic associated with the enterprise application.

Edwards fails to teach being able to renew or extend a service over a telephony network.

13/3, k/3 teaches a Florida citizens now able to renew vehicle registration via telephone wherein users can renew a service including vehicle registration or driving licenses if payment can be provided in the form of a check.

24/3, k/9 teaches a communication system wherein motorist would be able to renew a service by dialing a toll-free number and providing payment through MasterCard or Visa or a debit card in (see disclosure).

29/3 teaches a communication service wherein a debit card service can be purchased and renewed as long as payment can be provided, which in this case would be a credit card.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either secondary reference into that of Edwards thus making it possible to extend or renew services without having to go the service provider in person, saving transportation cost, providing convenience without having to invest in expensive equipment such as a computer and to able to use desired service before/after expiration.

Regarding claim 8, Edwards teaches an enterprise application system or service management system in (see fig. 4, fig. 6, fig. 11, col. 10 lines 25-30, col. 11 lines 30-45, col. 12 lines 27-40, col. 17 line 57-col. 18 line 8, col. 20 lines 33-53, col. 25 lines 30-50) comprising:

establishing a telephone call with a service subscriber over a PSTN

receiving identifying information with the telephone call to identify the subscriber

correlating the identifying information with the telephone call to identify the subscriber;

retrieving service information for a service subscribed by the subscriber and managing or providing services accordingly.

Edwards fails to teach being able to extend services or renew services using a telephone network.

13/3, k/3 teaches a Florida citizens now able to renew vehicle registration via telephone wherein users can renew a service including vehicle registration or driving licenses if payment can be provided in the form of a check.

24/3, k/9 teaches a communication system wherein motorist would be able to renew a service by dialing a toll-free number and providing payment through MasterCard or Visa or a debit card in (see disclosure).

29/3 teaches a communication service wherein a debit card service can be purchased and renewed as long as payment can be provided, which in this case would be a credit card.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either secondary reference into that of Edwards thus making it possible to extend or renew services without having to go the service provider in person, saving transportation cost, providing convenience without having to invest in expensive equipment such as a computer and to able to use desired service before/after expiration.

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Regarding claims 9-13, see the previous explanation as set forth regarding these claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **REXFORD N BARNIE** whose telephone number is 571-272-7492. The examiner can normally be reached on M-F 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CURTIS KUNTZ can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRIMARY EXAMINER
REXFORD BARNIE
07/05/05


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